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U.S. Patent and Trademark Office

City: Alexandria

State: Virginia

**CONCERNING APPLICATION:**

Applicant(s): John S. Yates, Jr., et al.

Serial No.: 09/385,394

Art Unit: 2183

Filed: August 30, 1999

Examiner: Richard Ellis

Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES

**AFTER FINAL - EXPEDITED PROCEDURE**


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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 09/385,394

Confirmation No.: 9093

Applicant: John S. Yates, Jr., et al.

Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES

Filed: August 30, 1999

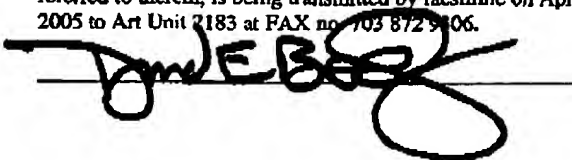
Art Unit: 2183

Examiner: Richard Ellis

Atty. Docket: 114596-03-4000

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**AFTER FINAL - EXPEDITED PROCEDURE****PETITION TO REOPEN PROSECUTION**

Mail Stop AF  
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P.O. Box 1450  
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Petitioner petitions for reopening of prosecution, after prosecution was prematurely closed by the Office Action of October 25, 2004, and on reconsideration February 14, 2005. Pursuant to MPEP § 706.07(c) and (d), Petitioner requests that prosecution be reopened, and that the Response to Office Action filed herewith be entered as of right.

The following questions are presented:

1. Is the consideration of claim 87 (which was not amended after the Office Action of February 2004) in the Office Action of October 2004 timely to support closing of prosecution?

No. First, under controlling precedent, a "new ground of rejection" arises when a subsequent paper "is factually based on an entirely different portion of an existing reference" relative to an earlier paper. The October 2004 paper relies on new portions of the reference, and therefore introduces a new ground of rejection of an unamended claim. Second, the Office Action of February 2004 raised no rejection at all – it was absolutely silent on all limitations of claim 87. Because of this omission from the February 2004 Action, any rejection raised in the October Office Action is necessarily a "new" ground. Claim 87 may not be finally rejected.

2. Does the Office Action of October 2004 timely comply with the requirements of 37 C.F.R. § 1.113 for final rejection of claim 22?

No. Rule 113 requires that any final Office Action "clearly" state the reasons for rejection. The October 2004 Office Action hints that the examiner has shifted from a single reference to a combination of references to meet a claim limitation, but the newly-applied references and portions thereof are not identified in the Office Action. Even in the Advisory Action, the portions relied on are not designated, and no pertinence is explained. An examiner may not prematurely close prosecution by playing "hide the ball."

3. Has examination been completed, in view of the Examiner's refusal to consider references properly submitted on an Information Disclosure Statement?

No. A number of references were submitted by Information Disclosure Statement in full compliance with all applicable rules. The Examiner's basis for refusing them consideration exceed his authority. Until examination is completed, closing prosecution is premature.

**I. The Issues Raised Here are Petitionable, Not Appealable**

Petitioner fully acknowledges that once an examiner has timely set his opinion down on paper, any difference with that opinion is solely appealable. For example, the issues with respect to claim 51 are fully developed, and ripe for appeal.

However, this petition concerns only issues where the examiner has acted untimely, or has been totally silent so it is not even clear whether a difference of opinion exists, let alone appealed. By definition, there can be no appeal from a position the examiner has not stated. The Federal Circuit<sup>3</sup>, the Board of Appeals, and the Director have all held that petition to the Director under Rule 181 is the appropriate avenue to raise untimely or incomplete examination, at least where the only relief requested is reopening of prosecution.

The Board of Patent Appeals and Interferences has long held that premature closing of prosecution is never appealable. *Ex parte Fine*, 217 USPQ 76, 79 (Bd. Pat. App. 1981) (precedential) ("We are likewise not concerned with the allegedly premature nature of the final

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<sup>3</sup> *In re Oetiker*, 977 F.2d 1443, 1449 (Fed. Cir. 1992) (Plager, J., concurring) ("The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner."); *In re Alappat*, 33 F.3d 1527, 1580, 31 USPQ2d 1545, 1588 (Fed. Cir. 1994) (*en banc*) (Plager, J., concurring) ("The [Director] has an obligation to ensure that all parts of the agency ... conform to official policy of the agency..."); see also *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1284-85, 73 USPQ2d 1409, 1414-15 (Fed. Cir. 2005) ("petition process [is] the 'exclusive administrative check' on the discretion of examiners," to ensure that examiners act within the PTO's rules).

rejection... This is an administrative matter subject to petition, not a substantive matter within our jurisdiction.”); *Ex parte Secor*, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd981052.pdf> (BPAI 2002) (unpublished) (premature final rejection “is reviewable by petition to the Director rather than by appeal to this Board.”).<sup>4</sup>

Because the issues presented in this petition, and the relief requested, are not appealable, they must be addressed when presented by Petition. 37 C.F.R. § 1.181(a)(1).

Second, the Commissioner of Patents and Trademarks (now the Director) holds that where the sole relief requested is reopening of prosecution – as in this petition – the issues are petitionable, even if they involve some consideration of the merits. *In re Oku*, 25 USPQ2d 1155, 1157 (Comm’r Pats and TM 1992) (emphasis supplied):

The designation of a new ground of rejection, while involving a consideration of the merits, also involves the important question of whether the Board followed PTO regulations established by the [Director]....

A decision to reopen prosecution ... is a question solely within the discretion of the [Director] and is in no way a review of a merits decision ...

Finally, issues are petitionable when “the rules specify that the matter is to be ... reviewed by the Director.” 37 C.F.R. § 1.181(a)(2). The relevant rule is MPEP § 706.07(c), which instructs as follows:

**706.07(c) Final Rejection, Premature**

Any question as to prematurity of a final rejection ... is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

The questions presented are within § 1.181(a)(2).<sup>5</sup>

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<sup>4</sup> Petitioner also notes that the Board has no jurisdiction to resolve issues that question an examiner’s compliance with 37 C.F.R. § 1.104 or the MPEP. *Ex parte Haas*, 175 USPQ 217, 220 (Bd. Pat. App. 1972) (“If the examiner fails to follow the Commissioner’s directions in the M.P.E.P., appellant’s remedy is by way of petition to the Commissioner since this Board has no jurisdiction over the examiner’s action.”) (Lidoff, examiner-in-chief, concurring), *rev’d on other grounds*, 486 F.2d 1053 (CCPA 1973).

<sup>5</sup> The Decision rendered May 30, 2003 stated that was vacated by the holding of mootness of the Decision on Petition rendered December 4, 2003.

This Petition is timely presented within two months of the examiner's action on reconsideration of February 14, 2005.

**II. The October Office Action Introduces a New Ground of Rejection of Claim 87, Which is Unamended**

An Action may not be made final when it introduces a new ground of rejection, where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

**A. The Office Action of October 2004 Relies on a New Portion of a Reference, and Therefore Introduces a New Ground of Rejection**

MPEP § 706.07(a) reads as follows, in pertinent part:

**706.07(a) Final Rejection, When Proper on Second Action**

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims...

MPEP § 706.07(a) imposes two separate requirements before prosecution may be closed: (a) all requirements of "present practice" must be timely fulfilled, and (b) no new ground of rejection may be raised, unless necessitated by amendment.

Neither the MPEP nor 37 C.F.R. define "new ground of rejection;" that definition must be found in the case law. A "new ground of rejection" is any new line of reasoning that requires a "fair opportunity to react to the thrust of the rejection." *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976). For example, relying on a new portion of a reference is a "new ground of rejection." *In re Wiechert*, 370 F.2d, 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference").

Since its original filing in 1999, claim 87 has recited a "control-transfer instruction of a computer ... architecturally defined to transfer control directly to a destination instruction." Claim 87 is the only claim that recites anything analogous to this limitation.

There is no dispute that the February 2004 Action contains no clement-by-element comparison of claim 87 to any reference. There is likewise no dispute that the February 2004 Office Action does not compare the "control transfer instruction" of claim 87 to any reference.

In contrast, the October 2004 Office Action, at paragraph 14.4, is the first to be "factually based" on col. 15, lines 48-50 of the Brender reference, or anything related thereto.

This citation to an "entirely different portion" of a reference is a "new ground of rejection" of an unamended claim.

Therefore, under MPEP § 706.07(a), closure of prosecution is premature. The appropriate relief is entry of the amendment filed contemporaneously herewith.

**B. The Office Action of February 2004 Did Not Raise Any Rejection of Claim 87: If Any Rejection of Claim 87 Exists in The October 2004 Action, It is a New Ground**

Untimely examination is petitionable, "wholly apart" from the merits of any rejection. MPEP § 706.07(c). The February 2004 Office Action stated no rejection of claim 87. Therefore, any rejection in the October 2004 Action is "new."

Under well-established principles of Administrative Law, an agency action taken in violation of "applicable departmental regulations" is "illegal and of no effect." *Accardi v. Shaughnessey*, 359 U.S. 535, 545 (U.S. Sup. Ct. 1959); *Schroeder v. West*, 212 F.3d 1265, 1269-70 (Fed. Cir. 2000). The February 2004 Action was required to comply with 37 C.F.R. § 1.104(c)(2), which reads as follows:

**§ 1.104 Nature of examination.**

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The February 2004 Office Action did not designate "the particular part relied on" vis-à-vis the "instruction" recited in claim 87. The February 2004 Office Action did not "clearly explain" the pertinence of the references (which total some 70 columns – surely "complex"). The February 2004 Action was no more than an invitation to Petitioner to attempt to guess at the

examiner's position – it was not itself a rejection. It did not comply with Rule 104(c)(2), and was therefore “illegal and of no effect.”

The Office Action of October 2004 now for the first time compares this language of claim 87 to a designated portion of a reference. The portion designated and now relied upon was never cited in the previous Office Action. Therefore, if any rejection exists in the October Office Action, it is untimely. It is at best a new ground not necessitated by amendment. MPEP § 706.07(a) prevents closure of prosecution in such circumstances.

**C. Both Office Actions are Too Incomplete to Support Final Rejection**

The Director instructs, as a matter of “procedure,” that the examiner bears the initial burden to come forward with three showings to support any rejection for obviousness:

**2142 Legal Concept of *Prima Facie* Obviousness**

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. ... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. ...

**ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner disagrees with the Director. In spite of several requests by Petitioner for some showing of “reasonable expectation of success,” the Examiner refuses to provide any such showing. Indeed, in the paper of February 10, 2003, Examiner Ellis states that he believes that “reasonable expectation of success” only applies in the chemical arts, not “all arts” as stated in MPEP § 2142.

Differences of opinion between an examiner and the Director's policies set out in the MPEP are petitionable.<sup>6</sup> Further, where an examiner has been totally silent, it is impossible to identify what difference of opinion might exist between applicant and examiner, let alone appeal

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<sup>6</sup> See Federal Circuit cases cited in footnote 3, and *Ex parte Haas* cited in footnote 4.

that difference. Until all required elements of an examiner's analysis are set down on paper, closure of prosecution is premature.

**D. Conclusion: Claim 87 Was Not Timely Examined; Closure of Prosecution is Premature**

Examination of claim 87 is untimely. At best, the October Action raises a new ground of rejection not necessitated by any amendment. Under MPEP § 706.07(a), finality of the Action of October 2004 is premature.

**III. The Status of Claim 22 is Too Unclear to Permit Appeal or Closure of Prosecution**

The October 2004 Office Action articulates no clear position on claim 22. An appeal brief directed to claim 22 can only ask the Examiner to set forth his position. Until the Examiner does so, an appeal brief cannot rebut showings that have not been made, or identify dependent claims that should stand or fall with claim 22. Because the Office Actions do not meet the requirements of 37 C.F.R. § 1.113(b) ("In making such final rejection, the examiner shall ... clearly [state] the reasons in support thereof."), or MPEP § 706.07 ("any such grounds relied on in the final rejection ... must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal"), prosecution may not be closed.

Claim 22 is discussed at paragraph 52 of the Office Action of the February 2004 and paragraph 14 of the October 2004 Office Action. Claim 22 recites as follows:

22. A method, comprising the steps of:

executing instructions fetched from first and second regions of a memory of a computer, the instructions of the first and second regions being coded for execution by computers following first and second data storage conventions, the memory regions having associated first and second indicator elements, the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed;

recognizing when program execution has flowed or transferred from a region whose indicator element indicates the first data storage convention to a region whose indicator element indicates the second data storage convention, and in response to the recognition, altering the data storage content of the computer to create a program context under the second data storage convention that is logically equivalent to a pre-alteration program context under the first data storage convention.



Paragraph 52.4 of the February 2004 Action compares the "the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed" to only Goetz '913, col. 17, lines 24-33 and to no other reference.

After Petitioner's paper of July 2004 fully responded to this issue, the October Action hints at a new ground of rejection, that "references may not be attacked individually," even though only a single individual reference was relied on for this element of claim 22. The October Office Action does not even specify which other references might be involved, let alone "designate the portions relied on."

Paragraph 4 of the February 2005 Advisory Action further confuses the issues: it merely states that unspecified portions of one or both of two other references might be used to supplement the Goetz '913 patent, in some unspecified way, to meet this claim limitation.

37 C.F.R. § 1.113 sets out the minimum requirements for a final rejection. Rule 113 reads as follows:

**37 C.F.R. 1.113. Final rejection or action.**

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

MPEP § 706.07 elaborates on § 1.113 as follows, emphasis added:

**706.07 Final Rejection**

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

....

In making the final rejection, all outstanding grounds of rejection ... must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply.

Until an Office Action states its position clearly, § 1.113 prevents closure of prosecution. Until an Office Action meets the requirements of § 1.104(c)(2), by designating the portions of each reference relied upon, and explaining the pertinence of these references, no rejection exists at all. On the current state of the record, it is unclear whether the examiner relies on a single

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reference to meet the "indicator elements" of claim 22, or on some combination. If the examiner relies on a combination, there is no statement whatsoever of what that combination is.

MPEP § 706.07 also makes clear that any final rejection must be stated in no more than two papers: the "single" previous Office action, and one final paper. The Examiner attempts to cure previous omissions in the February Advisory Action. However, an Advisory Action is both untimely, and improper in its attempt to inject a third paper into any appeal. Thus, the procedural requirements for closing prosecution are not satisfied.

Until grounds are explained timely and "clearly" in no more than two papers, Rule 113 and MPEP § 706.07 make clear that closing of prosecution is premature.

**IV. "Present Procedures" For Examination of the Application Were Not Completed – Closing of Prosecution Is Premature**

A number of non-patent references submitted on the Form 1449 filed July 12, 2004, and returned with the Action of October 2004, are crossed off the Form 1449 without consideration.

The pertinent rule reads as follows:

**§ 1.98 Content of information disclosure statement**

d) A copy of any ... publication ... listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

The Examiner does not dispute that all non-patent references listed on all IDS's filed in this application comply with Rule 98(d)(1): copies were "submitted, or cited by, the Office in an earlier application," they were submitted in those priority applications in fully-compliant IDS's, those priority applications are "properly identified" in the IDS's of this application, and are relied on for earlier effective filing dates under § 120.

The Examiner nonetheless refuses to consider these references. His reason appears to be a new requirement, not stated in Rule 98: he will only consider references in the IFW of the

direct parent, not in a "grandparent." Advisory Action of February 14, 2005 at page 3, line 14. But Rule 98(d)(1) states that a non-patent reference in the file of any priority application may be relied upon, so long as that priority application is identified in the IDS.

Because "present practice" was not observed in the Office Action of October 2004, MPEP § 706.07(a) does not authorize closure of prosecution. Because refusal of these references was not authorized, prosecution should be reopened so that the Examiner can complete examination of the entire application.

**V. Conclusion**

For these reasons, the finality of the Action of May 10, 2002 should be withdrawn. Prosecution should be reopened, and the Amendment filed concurrently herewith should be entered as of right (even without a showing of reasons under Rule 116).

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: April 8, 2005

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